

Application No. 10/619,987
Amendment dated February 17, 2009
Reply to Final Office Action of November 17, 2008

REMARKS

Applicant cancelled withdrawn claims 14-35, and amended claims 2, 4, and 43 to further define Applicant's claimed invention.

In the Office Action the Examiner objected to claim 2 based on informalities, i.e., insufficient antecedent basis for "said support member" limitation. In response, Applicant has amended claim 2 to recite "wherein said surface of at least one of said arm and said member is treated to enhance gripping of the vessel." Accordingly, Applicant submits that the Examiner's objection to claim 2 is now moot.

In addition, the Examiner rejected claims 1-13, 39-43, 45, and 46 (including independent claims 1, 7, 39, 45, and 46) under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. MPEP § 2163, in citing to Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991), states that "[a]n applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole." In fact, according to Vas-Cath, 935 F.2d at 1565, "drawings alone may provide a 'written description' of an invention as required by" 35 U.S.C. § 112, first paragraph. Accordingly, Applicant submits that many of the Examiner's rejections under 35 U.S.C. § 112, first paragraph, can be rebutted with reference to the drawings, if not the specification of the present application.

First, the Examiner indicates that, as recited in independent claim 1, "[n]ew limitation 'said arm and said member being biased toward one another in an open position' is new matter," and that "[c]laim 4 also has same problem." (Office Action, numbered paragraph 4.) As discussed in the Amendment of March 3, 2008 ("March 2008 Amendment"), the specification and the drawings were amended to include portions of U.S. Serial No. 08/111,634 which is incorporated by reference into the present application.

As discussed in the newly added first full paragraph of page 5 of the March 2008 Amendment, "when ligation clip 16 is opened, pressure arm 22 is pivoted about the connection point between base 20 and pressure arm 22," and "[t]he connection

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between base 20 and pressure arm 22 at proximate end 24 is a spring type connection (i.e., loop section 226 and tension coil 234) that tends to bias pressure arm 22 back into the at rest position as described previously." Accordingly, because of the spring type connection (afforded by the loop section 226 and the tension coil 234) disclosed in the newly added first full paragraph of page 5 of the March 2008 Amendment, at least the new portions of the specification support "said arm and said member being biased toward one another in an open position," as recited in independent claim 1, and "wherein said connector includes a coil biasing said arm and said member toward one another," as recited in dependent claim 4. As such, Applicant submits that independent claim 1 and dependent claim 4 are sufficiently supported by the specification and drawings of the present application.

Second, the Examiner indicates that, as recited in independent claims 1, 7, and 46, "[n]ew limitation 'the maximum length of said connector approximating the maximum height of said connector' is new matter." (Office Action, numbered paragraphs 5 and 9.) As recited in independent claims 1, 7, and 46, the maximum length of the connector is defined as being oriented generally along the longitudinal axis of the clip, and the maximum height of the connector is defined as being perpendicular to the maximum length. The Examiner acknowledges that in at least one embodiment of the present invention, the connector depicted in Fig. 2j has a circular configuration. (See Office Action, numbered paragraph 6.) Therefore, given the defined orientations of the maximum length and the maximum height of the connector recited in independent claims 1, 7, and 46, the maximum length and the maximum height can both be equal to the diameter of the connector. Accordingly, at least Fig. 2j supports the recitation of independent claims 1, 7, and 46 indicating that "the maximum length of said connector [approximates] the maximum height of said connector."

Third, the Examiner indicates that, as recited in independent claims 39 and 45, "[n]ew limitation 'the maximum length of said connector approximating the maximum height of said connector and being less than half of the maximum lengths of one of said support member and said clamping arm' is new matter," and claim 43 has the same

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problem (Office Action, numbered paragraphs 6-8.) As recited in independent claims 39 and 45, the maximum length of the connector is defined as being oriented generally along the longitudinal axis of the clip, and the maximum height of the connector is defined as being perpendicular to the maximum length. Therefore, as discussed above, at least Fig. 2j supports the recitation of independent claims 39 and 45 indicating that "the maximum length of said connector [approximates] the maximum height of said connector."

Furthermore, Fig. 2f (while also depicting a connector having a circular configuration) clearly shows that the connector thereof has a maximum length oriented along the longitudinal axis of the clip 16 that is less than half of the maximum lengths of both the base (or support member) 20 and the clamping arm 22 depicted therein. As such, at least Fig. 2f supports the recitation of independent claims 39 and 45 indicating that "the maximum length of said connector...[is] less than half of the maximum lengths of one of said support member and said clamping arm," and dependent claim 43 indicating that "the length of said connector is less than half of the lengths of said arm and said member."

Given that there is sufficient support for the above-discussed recitations in the specification and drawings of the present application, Applicant submits that the Examiner's rejection of claims 1-13, 39-43, 45, and 46 under 35 U.S.C. § 112, first paragraph, has been overcome.

Additionally, the Examiner rejected claims 1-13, 39-43, 45, and 46 (including independent claims 1, 7, 39, 45, and 46) under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,660,558 to Kees, Jr. ("Kees"). In rejecting independent claims 1, 7, 39, 45, and 46, the Examiner cites to In re Boesch, 617 F.2d 272 (CCPA 1980), and indicates that "it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to design the clip of Kees to have the dimension according to the dimension that (sic) claimed by the applicant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art." (Office Action, paragraph 13.)

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The key phrase in the Examiner's reasoning is "result effective variable." MPEP § 2144.05 entitled "Obviousness of Ranges" cites to In re Boesch and discusses result effective variables. However, MPEP § 2144.05 also cites to In re Antonie, 559 F.2d 618 (CCPA 1977), and indicates that "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." (MPEP § 2144.05 Part II.B.) Furthermore, in In re Antonie, the CCPA (citing to In re Aller, 220 F.2d 454 (CCPA 1955)) noted that "the discovery of an optimum value of a variable in a known process [i.e., a process producing a result effective variable] is normally obvious." (In re Antonie, 559 F.2d at 620.)

Kees discloses various embodiments of an aneurysm clip (10) having a central spring section (26), diverging first connecting portions (28) and (30), and jaws (20) and (22). According to Kees, the connecting portions (28) and (30) are manipulated to open the jaws (20) and (22). (See Kees at column 3, lines 20-26.) In doing so, pressure is applied to the connecting portions (28) and (30) to overcome the bias of the central spring section (26).

While Kees discloses the aneurysm clip (10), it does not disclose a process for selecting the dimensions of the central spring section (26) and the connecting portions (28) and (30). As such, the dimensions of the central spring section (26) and the connecting portions (28) and (30) of the aneurysm clip (10) of Kees are not result effective variables. Furthermore, the clip 16 of the present invention is not manipulated by applying pressure to the connector thereof. Therefore, because the clip 16 of the present invention is manipulated differently than the aneurysm clip (10), the teachings of Kees, even if disclosing a process producing a result effective variable, would be useless in determining the dimensions of the connector of the clip 16. Accordingly, Applicant submits that the Examiner's indication that the dimensions of the connector of independent claims 1, 7, 39, 45, and 46 are result effective variables fails. Hence, independent claims 1, 7, 39, 45, and 46 are not obvious under 35 U.S.C. § 103(a) in view of Kees.

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Applicant submits that independent claims 1, 7, 39, 45, and 46 are patentable and that dependent claims 2-6, 8-13, and 40-43 dependent from independent claim 1, 7, or 39, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-13, 36-43, 45, and 46 in condition for allowance. Applicant submits that the proposed amendments of claims 2, 4, and 43 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In conclusion, in view of the foregoing remarks, Applicant submits that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Accordingly, Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,
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